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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,757	01/29/2001	Kurt A. Schroder	5119-00108	1084

7590 12/10/2003
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EXAMINER

MEISLIN, DEBRA S

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/773,757

Applicant(s)

SCHRODER, KURT A.

Examiner

Debra S Meislin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 99-123 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 99-123 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

1. Applicant's election with traverse of figure 21 in Paper No. 10 is acknowledged. The traversal is on the ground(s) that a search and examination of the entire application can be made without undue burden upon the Examiner. The Examiner respectfully disagrees. A search and examination of the entire application cannot be made without undue burden upon the Examiner due to the various structures (species) disclosed. Since applicant has indicated that all claims are readable on the elected species, the arguments are deemed moot since all pending claims will be examined. However, any added claims directed to the non-elected embodiment(s) will be withdrawn from consideration.

If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The requirement is still deemed proper and is therefore made FINAL.

2. Claim 113 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The structure of the compartments coupled by a strip of material is not understood in view of the original specification and drawings.

3. Claim 113 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The compartments "coupled by a strip of material at the second end substantially distant from the impact surface" is not disclosed by the original disclosure and constitutes new matter.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the compartments "coupled by a strip of material at the second end substantially distant from the impact surface", the "compressible compartment filled with air disposed within the at least one cavity", the "compressible compartment filled with air disposed within the two cavities", and the "compartment filled with air disposed within the annular cavity" must be shown or the feature(s) canceled from the claim(s). Applicant is cautioned against the inclusion of new matter.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. Claim 103 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 103, "at least one cavity" should be --said at least one cavity-- since it is not clear as to how the "at least one cavity" in claim 103 relates to the "at least one cavity" in claim 99.

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 99-100, 103-105, 116-117, 120, 122-124, and 126 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Huang (5,355,552).

8. Claims 99-100, 104-105, 107-108, 114-115, and 124 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lay (2,884,969).

9. Claims 99-100, 102-105, 107-108, 110-111, 114-115, 124, and 126 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lay (2,983,296).

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 101 and 118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (5,355,552) in view of Soong (5,160,139).

Huang discloses all of the claimed subject matter except for the grasping member being less compressible than the material within the cavity/cavities. Soong discloses a grasping member surrounding a shank, a cavity between the grasping member and the shank, a compressible material in the cavity, and the grasping member being less compressible than the material within the cavity/cavities. It would have been obvious to one having ordinary skill in the art to form the grasping member of Huang

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('552) with a less compressible material to enable the handle to absorb impact as taught by Soong.

12. Claims 102 and 119 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (5,355,552) in view of Yamaguchi (4,738,166).

Huang discloses all of the claimed subject matter except for the grip having a surface of increased friction. Yamaguchi discloses a grasping member having a surface of increased friction. It would have been obvious to one having ordinary skill in the art to form the grasping member of Huang ('552) with a surface of increased friction to enable the handle to better gripped as taught by Yamaguchi.

13. Claims 106, 113, 121, and 125 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (5,355,552) in view of Peng (4,951,948).

Huang discloses all of the claimed subject matter except for having a compressible compartment within the cavity. Peng discloses a compressible compartment within a cavity (col. 3, lines 36-46). It would have been obvious to one having ordinary skill in the art to form the cavity of Huang ('552) with a compressible compartment therein to increase shock absorption as taught by Peng. Note that Huang discloses compartments coupled by strips of material.

14. Claims 101 and 109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lay (2,983,296) in view of Soong (5,160,139).

Lay discloses all of the claimed subject matter except for the grasping member being less compressible than the material within the cavity/cavities. Soong discloses a grasping member surrounding a shank, a cavity between the grasping member and the

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shank, a compressible material in the cavity, and the grasping member being less compressible than the material within the cavity/cavities. It would have been obvious to one having ordinary skill in the art to form the grasping member of Lay with a less compressible material to enable the handle to absorb impact as taught by Soong.

15. Claims 106, 112, and 125 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lay (2,983,296) in view of Peng (4,951,948).

Lay discloses all of the claimed subject matter except for having a compressible compartment within the cavity. Peng discloses a compressible compartment within a cavity (col. 3, lines 36-46). It would have been obvious to one having ordinary skill in the art to form the cavity of Lay with a compressible compartment therein to increase shock absorption as taught by Peng.

16. Any inquiry concerning this communication should be directed to Debra S Meislin at telephone number 703 308-3671. Official responses may be faxed to 703 872-9306.



D. S. Meislin
Primary Examiner
Art Unit 3723

November 25, 2003